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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,498	03/23/2000	Kevin Wayne Kirkeby	ROC990251US1	1318

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EXAMINER

DINH, KHANH Q

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 12/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/533,498

Applicant(s)

KIRKEBY, KEVIN WAYNE

Examiner

Khanh Dinh

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 14 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13, 15-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the Amendment and the Request for Continued Examination filed on 311/7/2003 (paper # 12). Claims 1-30 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 5-13, 15-23 and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman, US pat. No.6,020,980.

As to claim 1, Freeman discloses a method for processing a message in a network computing system including a facsimile transmission comprised of a recipient contact address

and message content (i.e., email address associated with a telephone number and a subscriber, see fig.3B and col.6 lines 9-29), wherein the message content includes at least one of message text and attached files, comprising:

managing with the facsimile server (computer terminal 112 fig.1) the facsimile transmissions as jobs (customer requests), transferring with the facsimile server (112 fig.1) the message content to a conversion computer (fax server 122 fig.1); maintaining, with the conversion computer, different attachment files in different file formats to images in an image file format (i.e., converting native facsimile objects files to standard bit maps, see fig.1 and col.6 line 50 to col.7 line 55), wherein a plurality of the application programs are capable of converting files in different file formats to the image file format and launching, with the conversion computer, at least one application program to convert image message content in a image file format (i.e., reformatting facsimile transmission formats into subscriber's selected formats including image, see abstract, fig. 1, col.6 line 30 to col.7 line 44).

transferring, with the conversion computer (122 fig.1), the converted message content to the facsimile server and transferring, with the facsimile server, the converted message content in the image file format to a communication port for transmittal to the recipient contact address (134, 136, 138 fig.1) (see col.8 line 7 to col.9 line 59 and col.10 lines 6-60).

As to claim 2, Freeman discloses transferring, with the facsimile server, a job number (facsimile number) assigned to the fax job to the conversion computer; and requesting, with the conversion computer, the message content for the job number, wherein the facsimile server

transfers the message content in response to receiving the request from the conversion computer (see col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 3, Freeman discloses maintaining with the facsimile server, a job table (table 1, col.8 lines 52-58) fax job records identified by job number and changing, with facsimile server, state fields in the fax job records to manage the workflow of the fax jobs between conversion computer, second computing systems, and communication port (see also fig.2, col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 5, Freeman discloses the message content is converted to one or more images in the image file format (see fig.2, col.7 line 45 to col.8 line 59).

As to claim 6, Freeman discloses determining one of multiple application programs capable of opening the attachment file and using the determined application program to convert the content of the attachment file to one or more images in the image file format, wherein all the images in the file format comprising the at least one converted attachment file are transferred to the facsimile server (see fig.2, col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 7, Freeman discloses converting, with the conversion computer, the message text to at least one image in the file format, wherein the images comprising the converted attachment files are arranged in a file in the file format according to an order in which they were

attached to the message and follow one image comprising the converted message text (see figs. 2, 3, col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 8, Freeman discloses maintaining, with the conversion computer, multiple application programs open to concurrently convert the content of different attachment files to images in the file format (see figs. 2, 3, col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 9, Freeman discloses that the different attachment files concurrently converted to images in the file format are part of different fax jobs (see figs. 2, 3, col.8 line 37 to col.9 line 59, col.10 lines 6-60 and col.12 lines 7-67).

As to claim 10, Freeman discloses one application program to concurrently convert the content of a different attachment files associated with the application program to images in the image file format (see figs. 2, 3, col.8 line 37 to col.9 line 59, col.10 lines 6-60 and col.12 lines 7-67).

As to claim 11, Freeman discloses a network computing system for processing a message including a facsimile transaction comprising of a recipient contact address and message content (i.e., email address associated with a telephone number and a subscriber, see fig.3B and col.6 lines 9-29), wherein the message content includes at least one of message text and attached files, comprising:

(a) a facsimile server (112 fig.1). It is inherent that a facsimile server, which is a computer terminal, has a processor and a memory to process data information.

(b) a conversion computer (fax server 122 fig.1) comprising a second memory (126 fig.11) and a communication port (116 fig.1) in communication with the facsimile server (see fig. 1, see abstract, col.6 line 9 to col.7 line 56). It is inherent that a fax server which has a processor to process data information

(c) first program logic residing in the first memory, wherein the first program logic, when read and executed by the first processor performs (see col.7 lines 11-56) for managing the facsimile transmission as a fax job, transferring the message content to a second computing system and transferring the message content received from the second computing system to a communication port for transmittal to the recipient contact address (see fig.2, col.7 line 57 to col.8 line 59).

(d) second program logic residing in the second memory, wherein the second program logic, when read and executed by the second processor performing of launching at least one application program to convert the message content to at least one image in a file format and transferring the converted message content in the file format to the first computing system (see col.8 line 7 to col.9 line 59 and col.10 lines 6-60).

Claims 12, 13, 15-20 are rejected for the same reasons set forth in claims 2, 3, 5-10 respectively.

Claim 21 is rejected for the same reasons set forth in claim 1. As to the added limitation, Freeman further discloses transferring the message content received from the second computer to

a communication port for transmittal to the recipient contact address (see col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

Claims 22, 23, 25-30 are rejected for the same reasons set forth in claims 2, 3, 5-10 respectively.

Response to Arguments

4. *Applicant's arguments with respect to claims 1-3, 5-13, 15-23 and 25-30 have been considered but are moot in view of the new ground(s) of rejection.*

Conclusion

5. Claims 1-3, 5-13, 15-23 and 25-30 are rejected.

6. Claims 4, 14 and 24 are allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam Hosain, can be reached on (703) 308-6662. The fax phone numbers for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.

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Khanh Dinh
Patent Examiner
Art Unit 2155
11/26/2003


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER